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REMARKS

Claims 14-38 are currently pending in the subject application and are presently under consideration. Independent claims 14 and 21 have been amended herein to further emphasize various aspects of the claimed invention. A version of all pending claims is found at pages 2-5. Favorable consideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 21-24, 28, 29, and 32 Under 35 U.S.C. § 103(a)

Claims 21-24, 28, 29, and 32 stand rejected under 35 U.S.C. §103(a) as being obvious over Petteruti *et al.* (U.S. 5,335,170) in view of what is well known in the art, as exemplified by Grime *et al.* (U.S. 5,236,129) and Sjostrand *et al.* (U.S. 3,019,673). Withdrawal of this rejection is respectfully requested for at least the following reason.

Petteruti *et al.* does not teach or suggest all limitations recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Ex parte Levengod*, 28 USPQ2d 1300 (P.T.O.B.A.&I. 1993).

The present invention relates generally to hand-held data acquisition devices. More specifically, the present invention is directed to data acquisition devices *with*

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improved ergonomic arrangement whereby operation of a keypad is supported against the main portion of a user's hand to provide more stable support as compared with conventional devices.

In particular, as recited in amended independent claim 21, the subject invention provides for a hand-held optical scanning device having a body including an optical scanning module arranged to scan objects in a direction outward from a first distal end, the body including an upper surface having a display mounted thereof, and a handle that extends from a bottom surface of the body at the first distal end to increase a viewing angle of the display, the handle being joined to the body to support a proximal end of the bottom surface of the body by resting the handle on a radial surface of a user's hand to provide support.

These claimed aspects are clearly not taught or suggested by the cited prior art. In particular, the subject claim, as amended, recites a handle that supports a proximal end of the bottom surface of the body by resting the handle on a radial surface of a user's hand. The Office Action dated February 10, 2005 incorrectly contends that Petteruti *et al.* discloses the limitations recited in independent claim 21 (and claims 22-24, 28-29 and 32 depending there from). Applicants' representative respectfully disagrees with the Examiner's contention.

Rather, Petteruti *et al.* is directed to a modular and portable system adapted to provide inventory control functions comprising a programmable master module including a display, a keypad, and processing electronics, and a scanning module for reading bar code symbols, where the master module is interconnectable with the scanning module (e.g., handle) to form a portable scanner for reading and analyzing bar code symbols, and the master module is adapted to interconnect to a plurality of other modules such as a printer module, an interface module, and a suitcase module. (See, Petteruti *et al.*, Abstract).

In the analysis set forth in the subject Office Action, the Examiner relies upon FIG. 2A of Petteruti *et al.* for support of teaching applicants' claimed invention. In particular, the Examiner contends that Petteruti *et al.* teaches a handle configurable to accommodate a user's hand. Secondly, the Examiner contends that the elevation of the

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user's radial surface of the hand and the elevation of the user's triggering finger are of an equal elevation when the user holds the handle portion of the scanner. Thus, the Examiner suggests that the radial surface of the user's hand would be adjacently located at the bottom surface of the body. Third, the Examiner finds no structure or element within the scanner that prevents the radial surface of the user's hand to support the bottom surface of the body.

With regard to each of these suggestions, applicants' representative respectfully disagrees. Particularly, although Petteruti *et al.* teaches a handle configurable to accommodate a user's hand, applicants' representative contends that, in accordance with the Examiner's analysis of Petteruti *et al.*, "the radial surface of the user's hand would be adjacently located to the bottom surface of the body." Petteruti *et al.* does not teach or suggest the handle extending over, and onto, the user's hand as recited in the subject claim. Rather than the novel handle structure resting onto a user's hand as recited in the subject claim, the cited reference suggests that a master module extends above a user's hand. Merely because the cited reference does not disclose a structure or element that prevents the radial surface of the user's hand to support the bottom surface, it is improper hindsight to assume that support would exist.

Furthermore, the Examiner takes Official Notice that a gun-shaped housing device having a body and a handle that extends from a bottom surface of the body in an angle is known. As well, the Examiner takes Official Notice that the bottom surface of such a body would rest on a user's hand. Applicants' representative respectfully disagrees with each of these assumptions.

Other than the Examiner's visual interpretation of Figure 2A, the Examiner fails to cite a specific reference within Petteruti *et al.* or otherwise for such contention. In lieu of citing a specific reference, the Examiner simply assumes that Figure 2A shows a portion (*e.g.*, the proximal end of the body) of the scanner's body extending outward toward a user such that when user grabs the handle, the upper portion of the body (*e.g.*, the proximal end of the body) would rest on the upper surface of the user's hand. Applicants' representative respectfully submits that the handle or "scanning module" of Petteruti *et al.* does not support a proximal end of the bottom surface of the body by

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resting on a radial surface of a user's hand as recited in the subject claim(s). Rather, it is the master module of Petteruti *et al.* that extends above a user's hand.

In support thereto, applicants' representative directs attention to FIG. 1 of Petteruti *et al.* Scanning module 12 is illustrated in FIG. 1. As well, programmable master module 10 is illustrated in FIG. 1. Applicants' representative respectfully submits that FIG. 2A cited by the Examiner is simply a combination of these two disparate modules. As such, it should be noted that the handle (e.g., scanning module) portion of Petteruti *et al.* would not extend over a user's hand at all. Therefore, the contention if the handle portion of Petteruti *et al.* would support a proximal end of the bottom surface of the body by resting on a radial surface of a user's hand is moot. Clearly, the handle of Petteruti *et al.* does not and cannot extend above user's hand. Rather, the master module of Petteruti *et al.* may extend above a user's hand upon combining the modules as set forth in FIG. 2A. In any case, Petteruti *et al.* does not teach or suggest the novel handle portion as recited in the subject claims.

As stated above, Figure 2A of Petteruti *et al.* merely indicates that "the proximal end of the scanner's body (e.g. the head portion 44 and the master module 10 combined) would extend over the radial surface of the user's hand upon a gripping position of the handle by the user." Clearly, the mere suggestive positioning "over the radial surface of the user's hand" does not disclose, teach or suggest that the proximal end of the body would rest on the user's hand as set forth in applicants' claimed invention. Nevertheless, the claimed invention recites that the *handle portion supports a proximal end of the bottom surface of the body by resting the handle on a user's hand.*

The Examiner relies upon Grime *et al.* and Sjostrand *et al.* for support and teaching of the novel aspects of resting on a user's hand. Applicants' representative respectfully asserts that these two references demonstrate that the present invention is classified in a crowded art. Accordingly, any small step forward should be regarded as significant. Moreover, although the cited references are directed to gun-like tools, they are specifically directed to power tools and paint sprayers, clearly not to the novel data acquisition apparatus disclosed and claimed in the subject application.

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With regard to the Examiner's Official Notice contentions, the Office Action relies on improper hindsight in reaching an obviousness determination. The Federal Court has held that to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988) (citations omitted).

For at least the foregoing reasons, it is readily apparent that Petteruti *et al.* individually or in combination with Grime *et al.* and/or Sjostrand *et al.* fails to teach or suggest all the claimed aspects of the subject invention. Accordingly, independent claim 21 (and claims 22-24, 28-29 and 32 depending there from) is believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 14-17, 20, and 33 Under 35 U.S.C. § 103(a)

Claims 14-17, 20, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Petteruti *et al.* in view of Wakatsuki *et al.* (U.S. 5,023,438). Withdrawal of this rejection is respectfully requested for at least the following reason. The Examiner cites Wakatsuki *et al.* in an attempt to cure the aforementioned deficiencies of Petteruti *et al.* However, Wakatsuki *et al.* fails to cure the deficiencies of Petteruti *et al.* as set forth *supra*.

Furthermore, Petteruti *et al.* and Wakatsuki *et al.*, alone or in combination, do not disclose, teach or suggest applicants' claimed invention. Independent claim 14 has been amended herein to emphasize various aspects of the claimed invention. As amended, independent claim 14 (and similarly independent claim 21) recites a handle that extends from *a bottom surface* of the body, the handle being joined to the body to cause the handle to rest on a surface of a user's hand to facilitate stability and weight distribution. As outlined *supra*, Petteruti *et al.* does not teach or suggest such claimed

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feature. Moreover, Wakatsuki *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.*

In view of at least the above comments, it is respectfully submitted that the rejection of independent claim 14, claims 15-17, 20 dependent therefrom, and claim 33 which depends from independent claim 21 should be withdrawn.

III. Rejection of Claims 34 and 38 Under 35 U.S.C. § 103(a)

Claims 34 and 38 stand rejected under 35 U.S.C. §103(a) as being obvious over Petteruti *et al.* as modified by Williamson *et al.* (U.S. 5,475,381). Withdrawal of this rejection is respectfully requested for at least the following reasons. Williamson *et al.* does not cure the above-identified deficiencies of Petteruti *et al.* Therefore, Petteruti *et al.* as modified by Williamson *et al.* alone or in combination, does not teach or suggest applicants' claimed invention.

Claims 34 and 38 depend from independent claim 21. Williamson *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.* with respect to the independent claim. Thus, the subject invention as recited in independent claim 21 (and claims 34 and 38 depending there from) is not obvious over Petteruti *et al.* as modified by Williamson *et al.* Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claim 36 Under 35 U.S.C. § 103(a)

Claim 36 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti *et al.* as modified by Wakatsuki as applied to claim 14, and further in view of Williamson *et al.* Withdrawal of this rejection is respectfully requested for at least the following reason. Petteruti *et al.* as modified by Wakatsuki *et al.* and Williamson *et al.* alone or in combination, do not teach or suggest applicants' claimed invention.

Claim 36 depends from independent claim 21. Wakatsuki *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.*, alone or in combination with Williamson *et al.* with respect to the independent claim. Thus, the subject invention as recited in independent claim 21 (and claim 36 depending there from) is not obvious over Petteruti *et al.* as modified by Wakatsuki *et al.*, and further in view of Williamson *et al.* Accordingly,

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withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 18 and 19 Under 35 U.S.C. § 103(a)

Claims 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti *et al.* as modified by Wakatsuki *et al.* as applied to claim 14, and further in view of Reynolds *et al.* (U.S. 5,828,052). Withdrawal of this rejection is respectfully requested for at least the following reasons. Petteruti *et al.* as modified by Wakatsuki *et al.* and Reynolds *et al.* alone or in combination, do not teach or suggest applicants' claimed invention.

Claims 18 and 19 depend from independent claim 14. Reynolds *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.*, alone or in combination with Wakatsuki *et al.* with respect to the independent claim. Thus, the subject invention as recited in independent claim 14 (and claims 18 and 19 depending there from) is not obvious over Petteruti *et al.* as modified by Wakatsuki *et al.*, and further in view of Reynolds *et al.* Accordingly, withdrawal of this rejection is respectfully requested.

VI. Rejection of Claims 25-27 and 30-31 Under 35 U.S.C. § 103(a)

Claims 25-27 and 30-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti *et al.* in view of Reynolds *et al.* Withdrawal of this rejection is respectfully requested for at least the following reasons. Petteruti *et al.* in view of Reynolds *et al.* alone or in combination, does not teach or suggest applicants' claimed invention.

Claims 25-27 and 30-31 depend from independent claim 21. Reynolds *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.* with respect to the independent claim. Thus, the subject invention as recited in claims 25-27 and 30-31 which depend from independent claim 21 is not obvious over Petteruti *et al.* in view of Reynolds *et al.* Accordingly, withdrawal of this rejection is respectfully requested.

VII. Rejection of Claim 37 Under 35 U.S.C. § 103(a)

Claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti *et al.* in view of Harden *et al.* (U.S. 5,237,162). Withdrawal of this rejection is respectfully requested for at least the following reasons. Petteruti *et al.* in view of Harden *et*

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al. alone or in combination, does not teach or suggest applicants' claimed invention.

Claim 37 depends from independent claim 21. Harden *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.* with respect to independent claim 21. Thus, the subject invention as recited in claim 37 is not obvious with respect to Petteruti *et al.* in view of Harden *et al.* Accordingly, withdrawal of this rejection is respectfully requested.

VIII. Rejection of Claim 35 Under 35 U.S.C. § 103(a)

Claim 35 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti *et al.* as modified by Wakatsuki *et al.* as applied to claim 14, and further in view of Harden *et al.* Withdrawal of this rejection is respectfully requested for at least the following reasons. Petteruti *et al.* as modified by Wakatsuki *et al.* as applied to claim 14, and further in view of Harden *et al.* alone or in combination, does not teach or suggest applicants' claimed invention.

Neither Wakatsuki *et al.* nor Harden *et al.* makes up for the aforementioned deficiencies of Petteruti *et al.* with respect to independent claim 14. Thus, the subject invention as recited in claim 35 is not obvious in view of the cited references. Withdrawal of this rejection is respectfully requested.

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CONCLUSION

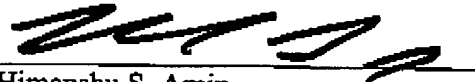
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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